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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,455	11/02/2001	Kirk Hibbert	7432.115USU1	4982

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EXAMINER

TO, TOAN C

ART UNIT

PAPER NUMBER

3616

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/008,455

Applicant(s)

HIBBERT, KIRK

Examiner

Toan C To

Art Unit

3616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 30, 31, 34 and 35 is/are rejected.
- 7) ☒ Claim(s) 12-29, 32, 33 and 36-50 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8-9, 30-31, and 34-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 8, 30, and 34, recitation "medium-weight hydraulic oil" renders the claims indefinite for being unclear, since it is not known what type of hydraulic oil is claimed.

As to claims 9, 31, and 35, recitation "light-weight hydraulic oil" renders the claims indefinite for being unclear with similar reasons as explained above.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6, and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakai (U.S. 5,486,018).

Sakai discloses a vehicle suspension system comprising a first shock absorber (102) comprising a first main piston (112) disposed therein, the first main piston being moveable between a retracted position wherein the first main piston is substantially

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retracted within the first shock absorber and an extended position wherein the first main piston is at least partially extended from the first shock absorber; a second shock absorber (102, it notes that reference number 102 have been used to designate a plurality of shock absorber) comprising a second main piston (112, it notes that reference number 112 have been used to designate a plurality of piston) disposed therein, the second main piston being moveable between a retracted position wherein the second main piston is substantially retracted within the second shock absorber and an extended position wherein the second main piston is at least partially extended from the first shock absorber; wherein the first and second shock absorbers movably linked with one another whereby when the first main piston is moved toward the retracted position, the second main piston is caused to move toward the retracted position.

As to claim 2, Sakai discloses a vehicle suspension system, wherein the first and second main pistons (112) are in phase, such that when the first main piston (112) moves towards said retracted position, the second main piston moves towards the retracted position.

As to claim 3, Sakai discloses a vehicle suspension system, further comprising an adjuster (115) in communication with said first and second main pistons (112), the adjuster being adapted for adjusting a neutral position of said first and second main pistons (112).

As to claim 4, Sakai discloses a vehicle suspension system, wherein said first and second shock absorbers (102) are hydraulic shock absorbers.

As to claim 5, Sakai discloses a vehicle suspension system, further comprising

a remote reservoir mechanism (252) adapted to accommodate motions of said first and second main piston.

As to claims 6, and 10-11, Sakai discloses a vehicle suspension system, wherein the first and second shock absorbers (102) comprise hydraulic fluid therein; wherein the vehicle suspension system is adapted to substantially avoid cavitation of said hydraulic fluid, and to be operable during cavitation of said hydraulic fluid (see column 26, lines 49-57).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakai in view of Supalla (U.S. 4,153,237).

Sakai discloses every element of the invention as discussed above except that the hydraulic fluid is synthetic hydraulic oil.

Supalla teaches a suspension unit for a vehicle, wherein the hydraulic fluid is synthetic hydraulic oil (see column 4, line 34).

It would have been obvious design choice to one having ordinary skill in the art at the time the invention was made to modify the suspension system of Sakai by using synthetic hydraulic oil as taught by Supalla in order to effectively absorb impact force on the wheel of the vehicle when traveling on uneven terrain.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the suspension system of Sakai by using synthetic hydraulic oil, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of suitability for the intended use as a matter of obvious design choice.

As best understood by the examiner, synthetic hydraulic oil as taught by Supalla is considered to correspond with medium-weight or light weight hydraulic oil as recited in claims 8-9.

#### ***Allowable Subject Matter***

7. Claims 12-29, 32-33, and 36-50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 30-31, and 34-35 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Lilbacka (U.S. 6,253,867), Valsanen (U.S. 6,390,219), Marier et al (U.S. 4,919,441), Kobayashi (U.S. 4,518,056), and Karpik (U.S. 5,881,834) disclose the suspension system having a first and second shock absorbers wherein each of the shock absorber includes a piston disposed therein.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Toan To whose telephone number is (703) 306-5951. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson, can be reached on (703) 308-2089. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2571. Any inquiry of a general nature or relating to the status of this application or this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1113.

To, T

September 15, 2003